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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,585	12/01/2005	Seiko Hirayama	F-8766	1212
28107 7590 11/25/2009 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
JOHNSON, KEVIN M				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
11/25/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,585

Applicant(s)

HIRAYAMA ET AL.

Examiner

KEVIN M. JOHNSON

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims require a "fluorescence-type phosphor," but what constitutes a "fluorescence-type phosphor" is not immediately clear. For the purposes of examination this limitation has been interpreted as requiring only that the phosphor exhibit fluorescence which by definition all phosphors exhibit.
3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is drawn to a method of producing a "phosphorescence type" phosphor, but is dependent on claim 10 which is drawn to a method of producing a "fluorescence-type" phosphor. This inconsistency makes it impossible to determine the scope of the instant claim, rendering the instant claim indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshio et al. (US 6096243) in view of Morihito et al. (JP 2000-144129).

In regard to claim 1, Oshio teaches a phosphor of the $Ba_{0.9}Eu_{0.1}MgAl_{10}O_{17}$ type (example 1). Oshio fails to teach the inclusion of an element selected from the group including In, W, Nb, Bi, Mo, Ta, Th and Pb.

Morihito teaches a phosphorescent material comprising Eu as an activator, in which the performance of the phosphor is improved by the inclusion of a coactivator that

is preferably Nb (abstract, claim 3). The inclusion of the coactivator improves the luminance of the material (abstract)

It would have been obvious to one skilled in the art at the time of the invention to utilize an Nb coactivator in the phosphor material taught by Oshio. Such a modification would have been motivated by the teaching in Morihito that phosphor compounds that utilize a Eu activator achieve increased performance (luminance) with the addition of an Nb coactivator. By definition a phosphor exhibits phosphorescence, and all materials that are phosphorescent are necessarily fluorescent (see fig. 2 in applicant's arguments). Therefore the fluorescence-type limitation in the instant claims carries no patentable weight.

In regard to claim 4, Morihito teaches that the amount of Nb coactivator in the phosphor is preferably between 0.0001 and 1 mol-% (paragraph 5).

In regard to claim 5, Oshio teaches that the phosphor may have the formula $(\text{Ba}_a\text{Sr}_b)\text{Mg}_e\text{Al}_{10}\text{O}_{17}$ where $0 < a < 1$, $0 \leq b \leq 1$ and $0 < e \leq 1$ (claim 73). The amount of Eu activator preferably used is seen in the exemplary embodiments in Oshio, $\text{Ba}_{0.9}\text{Eu}_{0.1}\text{MgAl}_{10}\text{O}_{17}$.

In regard to claim 6, it would necessarily follow that the phosphor disclosed by the teachings of Oshio and Morihito would have a whiteness value of at least 85 as expressed in terms of W value.

In regard to claim 7, Oshio teaches that the phosphor is produced by firing a mixture of precursors in a reducing atmosphere (column 6, lines 43-46).

In regard to claim 9, the mixture of precursors is fired in an oxidizing atmosphere prior to being fired in a reducing atmosphere in the process taught by Oshio (column 6, lines 5-8).

8. Claims 2, 3, 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshio and Morihito as applied to claims 1 and 7 above, and further in view of Bouchard et al. (US 3753759).

In regard to claim 2, Oshio teaches that after the phosphor is produced in the reducing step, it is rinsed and then dried with an oven (column 6, lines 64-67). It is not disclosed that the drying takes place in an oxidizing atmosphere.

Bouchard teaches that it is common to dry phosphors rinsed with deionized water in heated air (column 4, lines 17-21).

It would have been obvious to one skilled in the art at the time of the invention that the drying described in Oshio takes place in an oxidizing environment. This conclusion is supported by the teaching in Bouchard that after rinsing, phosphors are commonly dried by heating in air.

In regard to claims 3, 10 and 12, it is not taught that the coactivator additive taught by Morihito is added to the phosphor taught by Oshio after the mixture has been fired. Oshio teaches that the host raw material mixture is fired in an oxidizing atmosphere to produce the base material for the phosphor and is then combined with the raw material for the Eu activator. This mixture is then fired in a reducing atmosphere, before being washed and dried in an oxidizing atmosphere to produce the phosphor. It would have therefor been obvious to one skilled in the art at the time of the

invention to fire the base material and Eu mixture before adding the Nb coactivator precursor to the mixture. Such a modification would have been motivated by the teaching in Oshio that activators are beneficially added to an already fired raw material mixture.

In regard to claim 8, Oshio teaches that after firing in a reducing atmosphere, the phosphor is washed and then dried. It is not disclosed that the drying takes place in an oxidizing atmosphere.

Bouchard teaches that it is common to dry phosphors rinsed with deionized water in heated air (column 4, lines 17-21).

It would have been obvious to one skilled in the art at the time of the invention that the drying described in Oshio takes place in an oxidizing environment. This conclusion is supported by the teaching in Bouchard that after rinsing, phosphors are commonly dried by heating in air.

In regard to claim 11, Morihito teaches that multiple additives selected from Nb, Mo, Ta, W and Bi may be used as coactivators in Eu activated alkaline earth metal phosphors. It would therefor be obvious to one skilled in the art at the time of the invention that additional coactivators could be added to a fired product that contains a coactivator, as in the process taught by Oshio the activator is added to a fired mixture.

In regard to claim 13, Oshio teaches that to produce the phosphor that contains Eu effectively, the precursor mixture must be fired in a reducing atmosphere so that divalent Eu is present as the activator. It would therefor be obvious to one skilled in the

art at the time of the invention that the fired mixture to which the coactivator taught by Morihito is added must have been previously fired in a reducing atmosphere.

Response to Arguments

9. Applicant's arguments filed 7/9/2009 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Morihito is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Morihito is in the field of the applicant's endeavor as it is directed to the field of Eu activated aluminate phosphors. It is important to note that the rejection is not based on the Morihito reference alone, but the combined disclosures of Oshio and Morihito. Further, it is not clear how the extensive discussion in the arguments of the suitability of Morihito for use in PDP applications applies to the instant claims, as the claims do not require that the phosphor be suitable for use in PDP applications.

In response to applicant's argument that the prior art does not recognize that the inclusion of the coactivator improves the durability of the material, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The prior art recognizes that the inclusion of the coactivator improves the luminance of the material and extends the duration of the afterglow (abstract). While improved durability is not recognized, the inclusion of the coactivators for the reasons suggested by the prior art would necessarily produce the improved durability disclosed in the instant application.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 7:30 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M Johnson/
Examiner, Art Unit 1793

/David M Brunsman/
Primary Examiner, Art Unit 1793